



Docket No.: 2091-0233P
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Makoto HARA

Application No.: 09/773,629

Confirmation No.: 7712

Filed: February 2, 2001

Art Unit: 2625

For: METHOD, SYSTEM, AND RECORDING
MEDIUM FOR PRINTING SERVICE

Examiner: D. Q. Tran

PETITION UNDER 37 CFR §1.181 AND §1.144
FROM REQUIREMENT OF RESTRICTION

November 17, 2006

Attention: Director of Technology Center 2625
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

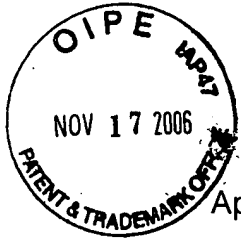
Sir:

In reply to the Restriction Requirements dated December 29, 2005 and July 11, 2006, the following remarks and Petition are respectfully submitted in connection with the above-identified application.

This reply includes:

Remarks; and

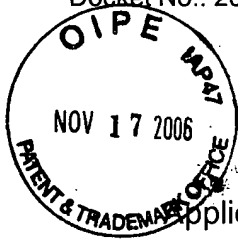
A Petition From Requirement of Restriction.



REMARKS

Applicant respectfully points out that on August 9, 2006, Applicant filed an Alternative Petition under 37 CFR §1.181 and §1.144 from a Requirement of Restriction concurrently with filing a Reply to a Restriction Requirement, wherein Applicant requested that the Petition be forwarded to the Director if the Examiner was to maintain the requirement.

Subsequently, Applicant telephoned the Examiner, Douglas Tran, on October 24, 2006 and the Examiner's Supervisor, David Moore, on October 25, 2006 to further request that the Petition be forwarded to the appropriate destination. To date, it appears that the Examiner and his Supervisor, noted above, have failed to forward the Petition to the Director's Office. As such, Applicant is herewith submitting a secondary copy of said Petition for the Director's review.



PETITION under 37 CFR §1.181 and §1.144

Applicant hereby petitions the (1) Restriction Requirement dated December 29, 2005 and the making of that requirement final in the subsequent Restriction Requirement dated July 11, 2006 and also petitions the (2) Restriction Requirement dated July 11, 2006, and the making of that requirement final on October 18, 2006. Applicant further respectfully requests that the Director withdraw both Restriction Requirements noted above and require the Examiner to prepare and mail an Office Action that treats all pending claims, i.e., claims 1-12 and 14-17, on their merits.

It is also noted that, because this petition is being filed under 37 CFR §1.181, there is no fee needed to file this petition.

The Restriction Requirement of December 29, 2005

The Examiner required restriction between the following groups of claims:

Group I, claims 1-12, drawn to a printing service method and system as well as a computer medium for use therein allegedly classified in class 358, subclass 1.9; and

Group II, claims 14-17, drawn to a printing service method and system as well as a computer medium for use therein including a plurality of collaborating systems wherein one of them is chosen and asked about the authentication information, classified in class 358, subclass 1.15.

In support of the requirement for restriction, the Examiner wrongly asserts that claims 1-12 are limited to a single collaborating system, whereas claims 14-17 include a plurality of collaborating systems.

Applicant respectfully traverses this restriction requirement for the following reasons:

Firstly, applicant respectfully submits that nothing in claims 1-12 recite “a single collaborating system”. The word “single” is neither expressly used nor implied in claims 1-12. In fact, claims 1-12 use the term “comprising” which one skilled in the art would recognize as signifying an open-ended claim. In other words, claims 1-12 are generic to a printing service using either a single or plural collaborating systems. However, there is absolutely no limitation to a single collaborating system in claims 1-12.

Applicant respectfully point out that in the absence of any expressed limitations reciting a single collaborating system, it is clear that claims 1-12 are generic and must be examined with the invention of claims 14-17.

Secondly, the Examiner has the burden of showing restrictability by establishing the presence of independence or distinctness. No such reason has ever been advanced by the Examiner. Applicant respectfully submits that the advancement of an alleged reason to support the existence of burden is not sufficient. See MPEP §803 and in particular MPEP §808.01.

Thirdly, applicant respectfully submits that even if the alleged basis for restrictability is that of different species, such a basis is clearly flawed since there is nothing in the claims 1-12 to require only a single collaborating system as alleged by the Examiner.

Although applicant felt that the December 29, 2006 Restriction Requirement was flawed, in a Reply dated April 25, 2006, applicant elected, with traverse, Group II, Claims 14-17.

In the subsequent Restriction Requirement of July 17, 2006, the Examiner failed to comment/address our request for reconsideration filed April 25, 2006. It is therefore assumed that such a requirement was maintained and made final.

The Restriction Requirement of July 17, 2006

The Examiner withdrew claims 1-12 from consideration and required restriction between the following groups of claims:

Group I, claims 14 and 16, drawn to a method and program for asking a chosen collaborating system about the authentication information if the authentication information is associated with the chosen collaborating system; and

Group II, claims 15 and 17, drawn to a service system comprising an authentication means for asking a plurality of collaborating systems about the authentication information if the authentication information is associated with at least one of collaborating systems.

In support of the requirement for restriction, the Examiner asserts the following:

"The inventions are distinct, each from the other because of the following reasons: Inventions II and I are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if at least one subcombination is separately usable. In the instant case, each invention has separate utility such as operating either independently or in combination with other subcombinations according to the particular claimed

limitations which characterize the invention, without requiring the particular limitations which characterize the other invention(s), as indicated above. See MPEP §806.06(d)."

Applicant also respectfully traverses this restriction requirement for the following reasons:

Firstly, applicant respectfully points out that that Examiner never addressed our arguments regarding the restriction of claims 1-12 and 14-17, in direct violation of the requirements of MPEP §707.07(f), thereby tacitly admitting that the Examiner's position is in error in this regard. Furthermore, the Examiner has denied applicant its fundamental substantive and procedural due process as required by the Administrative Procedures Act.

Secondly, applicant respectfully submits that the restriction requirement is fundamentally improper because it does not establish a two-way distinctness as required by MPEP §806.05(c). MPEP §806.05(c) sets forth what must be established by an Examiner in making a restriction requirement between a combination and a sub-combination invention. That test has not been made, however, and as a result, this restriction requirement is fundamentally improper. The Examiner merely makes a broad statement that each invention has separate utility without providing any basis for making such a statement.

Thirdly, applicant respectfully submits that a restriction should never be required if the search and examination of an entire application can be made without serious burden, even though the application contains claims to independent and distinct inventions. See MPEP §803. The reasons for this are (a) that there are two criteria for

proper restriction between patentably distinct inventions. The first is that the inventions must be independent or distinct as claimed, and the second is that there must be a serious administrative burden on the examiner to examine the claimed inventions; and (b) 35 U.S.C. §121 makes restriction discretionary by stating that the Director may require an application to be restricted to one of two or more independent and distinct claimed inventions in an application. With respect to the issue of "serious administrative burden," MPEP §§803, 808, 808,01 and 808,02 discuss and explain USPTO accepted meanings of serious administrative burden. In this regard, the restriction requirements never even addresses the issue of serious administrative burden, and is fundamentally improper for this reason alone.

Fourthly, applicant respectfully submits that this newest restriction requirement is evidence of the Examiner's attempt to conduct piecemeal prosecution. The Examiner has issued four (4) Office Actions, three (3) of which have included restriction/election requirements. No actions on the merits have ever been issued by this Examiner.

MPEP §707.07(g) warns that piecemeal examination should be avoided as much as possible. An Examiner ordinarily should reject each claim on all valid grounds available, avoiding, however, under multiplication of references. Here, the Examiner has failed to provide any valid rejections on the merits and is instead attempting to improperly segregate the claims into a multiplicity of groups without providing a *prima facie* case for restrictability.


Action Sought

For the reasons stated above, applicant respectfully submits that both the December 29, 2005 and the July 11, 2006 Restriction Requirements are without basis and should be withdrawn. Furthermore, applicant requests that the Restriction Requirements, which both have been made final, be withdrawn, and that the Examiner be directed to withdraw all of the outstanding Restriction Requirements in its entirety and prepare and mail a new, non-final Office Action on the merits of all pending claims, i.e., of claims 1-12 and 14-17.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment from or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17; particularly, the extension of time fees.

Dated: November 17, 2006

Respectfully submitted,

By  #39,491
Michael K. Mutter
Registration No.: 29,680
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant


MKM/CTB/jen



82 JAC

PTO/SB/21 (09-06)

Approved for use through 03/31/2007. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

Application Number 09/773,629-Conf. #007712

Filing Date February 2, 2001

First Named Inventor Makoto HARA

Art Unit 2625

Examiner Name D. Q. Tran

Attorney Docket Number 2091-0233P

ENCLOSURES (Check all that apply)

☐ Fee Transmittal Form

☐ Fee Attached

☐ Amendment/Reply

☐ After Final

☐ Affidavits/declaration(s)

☐ Extension of Time Request

☐ Express Abandonment Request

☐ Information Disclosure Statement

☐ Certified Copy of Priority Document(s)

☐ Reply to Missing Parts/ Incomplete Application

☐ Reply to Missing Parts under 37 CFR 1.52 or 1.53

☐ Drawing(s)

☐ Licensing-related Papers

☐ Petition

☐ Petition to Convert to a Provisional Application

☐ Power of Attorney, Revocation Change of Correspondence Address

☐ Terminal Disclaimer

☐ Request for Refund

☐ CD, Number of CD(s) _____

☐ Landscape Table on CD

☐ After Allowance Communication to TC

☐ Appeal Communication to Board of Appeals and Interferences

☐ Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)

☐ Proprietary Information

☐ Status Letter

☒ Other Enclosure(s) (please Identify below):

Return Receipt Postcard

Petition Under 37 CFR §1.181 and §1.144 From Requirement of Restriction

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name BIRCH, STEWART, KOLASCH & BIRCH, LLP

Signature  #39,491

Printed name Michael K. Mutter

Date November 17, 2006

Reg. No. 29,680

CAB